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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/731,780 12/08/00 TIRAMANI

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PM82/0904

EXAMINER

HANSEN, J

ART UNIT

PAPER NUMBER

3636

DATE MAILED:

09/04/01 *9*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/731,780

Applicant
TIRAMANI et al.

Examiner
James O. Hansen

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3636



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 28, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-115 is/are pending in the application.
- 4a) Of the above, claim(s) 48-56, 59-64, 69-71, 73-85, 93, and 98-113 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-47, 57, 58, 65-68, 72, 86, 88, 90-92, 95-97, 114, and 115 is/are rejected.
- 7) ☒ Claim(s) 89 is/are objected to.
- 8) ☒ Claims 41-115 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☒ Interview Summary (PTO-413) Paper No(s). 7
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 & 8 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Group I consisting of Figures 1-13b, 15a-17b, 18a-20 and 21c-26a; and Group II consisting of Figures 27-31.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least claim 41 is considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Jack Barufka on August 28, 2001 a provisional election was made with traverse to prosecute the invention of Group I, claims 41-115, applicant later called back and changed the earlier election so as to prosecute the invention of **Group II**, claims 41-47, 51, 57-58, 65-68, 72, 86-92, 94-97 & 114-115. Affirmation of this election must be made by applicant in replying to this Office action. Claims 48-50, 52-56, 59-64, 69-71, 73-85, 93, & 98-113 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Claim 51 is further withdrawn from consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. The examiner notes that claim 51 is drawn to nonelected species [Group I] since the elected embodiment does not have “one or more drawer spaces”, a “storage drawer” for each of the spaces, and the “toolbox” is not “secured to said storage drawer assembly such that said toolbox and said storage drawer assembly remain secured together during removal” [as best understood, there is no securing means depicted in the elected embodiment - as opposed to the latch assembly depicted in the nonelected species]. For these reasons, claim 51 is withdrawn from further consideration by the examiner.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Specification

5. The disclosure is objected to because of the following informality: The specification should be amended to read "This application is a continuation of U.S. Application No. 09/433,352, filed November 4, 1999 now U.S. Patent No. 6,176,559, which in turn is a continuation of U.S. Application No. 09/017,197, filed February 2, 1998 now abandoned". ✓

Appropriate correction is required.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required [i.e., references shown in the drawings and identified in the specification]: ✓
The specification lacks antecedent basis for the terminology of "base container", "removable container", "latch assembly", "hand grip portion", "toolbox", "container portion", "lid", "pair of latches", "carrying handle" and "an upwardly facing opening" as relating to the elected embodiment [figures 27-31].

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Claim Objections

7. Claims 41, 67, 88 and 96 are objected to because of the following informality: In Claim 41, line 9, the phrase "removably mounted said" should be changed to --removably mounted above said--. In Claims 67, 88 & 96, lines 9, 9 & 11 respectively, the phrase "into container portion" should be changed to --into said container portion--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 41-47, 57-58, 65-68, 72, 86-87, 94-97 & 114-115 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 41, 67 & 96 fail to recite sufficient interconnection of the elements to positively position and define the placement of the "wheels" so that an integral structural apparatus is defined which is able to function as claimed [note the interconnection of the "wheel" limitation in claim 88, line 4]. In Claim 42, the phrase "latches connected on opposing sides of one of said base and removable containers" is unclear and confusing as presently recited since it is not clear if applicant is claiming the limitation of the latches being connected to the base, or to the container {singular} or two both. In Claim 43, the phrase "the other of said base and removable containers" is unclear for the reasons set forth above. In Claims 65, 86, 94 & 114, the phrase "said handle" does not have proper antecedent

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basis [which handle i.e., the pulling handle or the carrying handle]. Consequently, the remaining claims are rendered indefinite because they are dependent upon a rejected claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

11. Claims 41-47, 57-58, 65-66, 96 & 114-115 are rejected under 35 U.S.C. 102(b) as being anticipated by Spranger et al. Spranger (figures 1-8) teaches of an apparatus comprising: As to claims 41 & 96, a base container (14) having an interior space; ground engaging wheels (22) on the apparatus; a removable container (viewed as the combination of members 10 & 12 in as much as applicant depicts a removable container - 206 comprised of members 212 & 214) having an interior space, the removable container being removably mounted to the base container, the removable container having a carrying handle (11) enabling a user to carry the removable container; a latch assembly (15) securing the removable container above the base container and being releasable to enable the removal of the removable container from the base container; and a manually engageable pulling handle (16) having a hand grip portion (51, 52 or 58), the pulling handle and the wheels being arranged on one side of the apparatus (fig. 3) enabling a user to tilt

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the apparatus and roll the apparatus to a desired location. As to claims 42-44 & 58, the latch assembly comprises a pair of latches (15 & 15') connected on opposing sides of the base container (view figs. 6-7 for example) and engage the removable container in secure latched positions. As to claim 45, the removable container comprises a "toolbox" (12 or 10) having a generally upwardly facing opening (when the "toolbox" is removed from the base container and oriented on it's side ~~or~~ with the apparatus having both the pulling handle and wheels parallel to the ground) and a pivoting lid (12A or 10A) movable between open and closed positions. As to claim 46, the carrying handle (11) is provided on the pivoting lid of the "toolbox". As to claim 47, the "toolbox" has a releasable latch (17A) on the lid for latching the lid to the body of the "toolbox". As to claim 57, the "toolbox" is mounted directly above the base container (fig. 1). As to claims 65 & 114, the carrying handle is connected directly to the removable container. As to claim 66 & 115, the wheels are fixedly attached to the base container via member (18).

12. Claims 41-43 & 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayer.

Mayer (figures 1-9) teaches of an apparatus comprising: As to claim 41, a base container (14) having an interior space; ground engaging wheels (36, 38) on the apparatus; a removable container (viewed as the combination of members 16 & 18 in as much as applicant depicts a removable container - 206 comprised of members 212 & 214) having an interior space, the removable container being removably mounted to the base container, the removable container having a carrying handle (middle 100) enabling a user to carry the removable container; a latch assembly (82) securing the removable container above the base container and being releasable to

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enable the removal of the removable container from the base container; and a manually engageable pulling handle (upper 100) having a hand grip portion (fig. 6), the pulling handle and the wheels being arranged on one side of the apparatus (fig. 3) enabling a user to tilt the apparatus and roll the apparatus to a desired location. As to claims 42-43, the latch assembly comprises a pair of latches (one on each side of the containers) connected on opposing sides of one of the containers and engage the other of the containers in secure latched positions. As to claim 65, the carrying handle is connected directly to the removable container.

13. Claims 41-45, 57-58, 65-66, 96 & 114-115 are rejected under 35 U.S.C. 102(e) as being anticipated by Chi. Chi (figures 1-7) teaches of an apparatus comprising: As to claims 41 & 96, a base container (10) having an interior space; ground engaging wheels (fig. 1) on the apparatus; a removable container (20) having an interior space, the removable container being removably mounted to the base container, the removable container having a carrying handle (21) enabling a user to carry the removable container; a latch assembly (40) securing the removable container above the base container [depending upon viewed orientation] and being releasable to enable the removal of the removable container from the base container; and a manually engageable pulling handle (fig. 1) having a hand grip portion (fig. 1), the pulling handle and the wheels being arranged on one side of the apparatus (fig. 1) enabling a user to tilt the apparatus and roll the apparatus to a desired location. As to claims 42-44 & 58, the latch assembly comprises a pair of latches connected on opposing sides of the base container (fig. 6) and engage the removable container in secure latched positions. As to claim 45, the removable container comprises a

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“toolbox” (20) having a generally upwardly facing opening (when the “toolbox” is removed from the base container and oriented on it’s side **or** with the apparatus having both the pulling handle and wheels parallel to the ground) and a pivoting lid (depicted in figs. 1 & 6) movable between open and closed positions as is conventional in the art. As to claim 57, the “toolbox” is mounted directly above the base container [depending upon viewed orientation]. As to claims 65 & 114, the carrying handle is connected directly to the removable container. As to claim 66 & 115, the wheels are fixedly attached to the base container via member (18).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 67-68, 72, 86-87 & 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spranger et al. Spranger teaches applicant’s inventive claimed concept as disclosed above, but does not show a plurality of latches [Spranger uses one latch 17 to secure the lid] for releasably latching the lid. However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of Spranger so as to incorporate a pair of latches, since it has been held that mere duplication of the essential working

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parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193

USPQ 8.

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 41-47, 57-58, 65-68, 72, 86-88, 90-92, 94-97 & 114-115 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,176,559 in view of Spranger et al. Claims 1-21 of U.S. Patent 6,176,559 disclose a base container (lower storage container - lsc); ground engaging wheels (ground engaging wheels); a removable container (removable upper storage container - rusc), the removable container (rusc) being removably mounted to the base container (lsc); a pivoting lid (pivoting lid) with a carrying handle (handle); and a manually engageable pulling handle (manually engageable handle member - mehm), the pulling handle and the wheels being arranged on one side of the apparatus enabling a user to tilt the apparatus and roll the apparatus to a desired location;

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but does not recite a latch assembly securing the removable container (rusc) to the base container (lsc). However, Spranger discloses a latch assembly as disclosed above. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the apparatus of U.S. Patent 6,176,559 so as to incorporate a latch assembly as taught by Spranger because a latch assembly would securely hold vertically stacked containers (col. 2, lines 30-34). As to the latch assembly comprising a pair of latches, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the prior art so as to incorporate a pair of latches, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

Allowable Subject Matter

18. Claim 89 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

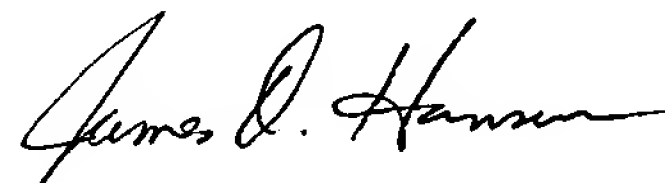
Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shamah and the Craftsman Catalog both describe a wheeled apparatus comprising a plurality of stacked containers along with a pulling handle.

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Any inquiry concerning this communication from the examiner should be directed to James O. Hansen whose telephone number is (703) 305-7414. Examiner Hansen can normally be reached Monday to Friday from 9:00 A.M. to 5:00 P.M. Eastern Time Zone.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2168. Fax numbers for Official Papers are as follows: (703) 305-3597 & (703) 305-7687. The unit fax phone number for Unofficial Papers is as follows: (703) 308-3691.



James O. Hansen
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JOH
August 30, 2001